



AF 2665
JF/11

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q54622

Christian LAROQUE, et al.

Appln. No.: 09/323,135

Group Art Unit: 2665

Confirmation No.: 8820

Examiner: Justin M. PHILPOTT

Filed: June 01, 1999

For: SWITCH PROVIDED WITH A SIGNALLING COUPLER, AND A METHOD OF
SENDING A SIGNALLING MESSAGE

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

In response to the Notification of Non-Compliant Appeal Brief mailed March 28, 2006, Applicant respectfully submits that the subject matter claimed in the independent claims is adequately described in the Summary of the Claimed Subject Matter section of the Appeal Brief filed January 23, 2006. Although there is no requirement to separately address each argued claim (MPEP § 1205.02.v), to obviate the Notification of Non-Compliant Appeal Brief, Applicant is submitting herewith an Amended Appeal Brief in which each argued claim is separately addressed.

Applicant respectfully submits that the Amended Appeal Brief complies with the rules and therefore requests an Examiner's Answer.

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

Although Applicant believes that no fee is due, the USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: April 26, 2006

Nataliya Dvorson
Registration No. 56,616

Attorney Docket No.: Q54622



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q54622

Christian LAROQUE, et al.

Appln. No.: 09/323,135

Group Art Unit: 2665

Confirmation No.: 8820

Examiner: Justin M. PHILPOTT

Filed: June 01, 1999

For: SWITCH PROVIDED WITH A SIGNALLING COUPLER, AND A METHOD OF
SENDING A SIGNALLING MESSAGE

AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST.....	2
II. RELATED APPEALS AND INTERFERENCES	3
III. STATUS OF CLAIMS	4
IV. STATUS OF AMENDMENTS.....	5
V. SUMMARY OF THE CLAIMED SUBJECT MATTER	7
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	13
VII. ARGUMENT.....	14
VIII. CONCLUSION	28
CLAIMS APPENDIX	29
EVIDENCE APPENDIX:	32
RELATED PROCEEDINGS APPENDIX.....	33

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

I. REAL PARTY IN INTEREST

The real party in interest is ALCATEL, by virtue of an assignment executed by Christian LAROQUE and Jacques LITTEAUT (hereinafter “Appellant”) on April 8, 1999, and recorded by the Assignment Branch of the U.S. Patent and Trademark Office on January 14, 2000, at Reel 010500, Frame 0626.

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-13 are all the claims pending in the application. Claims 1-8 and 11-13 stand rejected. The Examiner has indicated that claims 9 and 10 contain allowable subject matter.

Claims 12 and 13 are rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement.

Claims 1, 3, 5, 7, and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,595 to Hickey et al. (hereinafter “Hickey”).

Claims 2, 4, 6, and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al. (hereinafter “Kabay”).

IV. STATUS OF AMENDMENTS

With the filing of this Brief, all Amendments have been entered and considered by the Examiner.

The Application was originally filed with claims 1-4.

In response to the Non-Final Office Action mailed October 3, 2002, Appellant filed an Amendment under 37 C.F.R. § 1.111 in which claims 1-4 were amended and claims 5-8 were added.

In response to the Final Office Action mailed March 6, 2003, Appellant filed an Amendment under 37 C.F.R. § 1.116 in which claims 1-4 were amended.

Appellant filed a Request for Continued Examination (RCE) on July 31, 2003 to force entry of the after final Amendment.

In response to the Non-Final Office Action mailed October 7, 2003, Appellant filed an Amendment under 37 C.F.R. § 1.111 in which claims 1-3 were amended.

In response to the Final Office Action mailed March 26, 2004, Appellant file a Request for Reconsideration under 37 C.F.R. § 1.116. In this Response, no amendments were made.

In response to an Advisory Action mailed August 26, 2004, Appellant filed a Request for Continued Examination (RCE) and Amendment under 37 C.F.R. § 1.114(c) on September 15, 2004. In the Amendment, claims 1-3, 7, and 8 were amended and claims 9-13 were added.

In response to the Non-Final Office Action mailed December 2, 2004, Appellant filed an Amendment under 37 C.F.R. § 1.111 in which claims 10 and 11 were amended.

In response to the Final Office Action mailed June 23, 2005, Appellant filed a Response under 37 C.F.R. § 1.116. In this Response, no amendments were made.

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

Appellant filed a Notice of Appeal to appeal the final rejections of claims 1-8 and 11-13 on November 21, 2005.

The Appendix included with this Brief, sets forth the claims involved in the appeal and reflects the claim changes made in the above-identified Amendments.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a switch provided with a signaling coupler and a method for sending signaling messages.

In the conventional techniques, analog and digital data such as speech is conveyed in "B" channel between various parties. Also, "D" channel is provided for control data, which is commonly known as signaling data (page 1, line 14 to page 2, line 8 of the specification). In the conventional techniques, there are many protocols for organizing a link between two exchanges. When the network is not uniform in that it contains a variety of communications channels, the signaling message cannot be conveyed or in order to convey the message, there must be as many transcoders for forwarding the signaling messages as there are pairs of different transmission protocols for such signaling messages. Given the wide variety of protocols that can be used within these channels such signaling transcoding is not undertaken. The whole advantage of the signaling channel is lost when the network is not uniform (page 2, lines 9 to 33 of the specification).

In the Appellant's invention, however, the sending of the signaling message is given the syntax of a predetermined order (instruction). The predetermined order is always the same, regardless of the resources available in a telephone exchange for conveying a signaling message. In addition, each exchange (switch) has an interpreter for producing a signaling configuration that corresponds to the signaling message transmission resources accessible from the communication exchange, and the interpreter is set into operation in response to receiving the predetermined order. Accordingly, each exchange can transmit signaling messages using its own

protocols without having to develop special equipment *i.e.*, transcoders (page 3, lines 5 to 24 of the specification).

In the Appellant's invention, a signaling coupler is placed in a telephone exchange. The signaling coupler has a physical interface for voice channels (B channel type) and a physical interface for signaling channels. The physical voice interface is connected to a digital B channel output and/or analog B channel output. The physical signaling interface has a number of circuits, each relating to interfacing a different protocol such as IP protocols, a frame relay protocol, an ATM protocol, a switched X25 protocol, a generic modem protocol, a QSIG protocol, a switched B channel protocol and so on (Fig. 1; page 4, lines 15 to 37 of the specification).

The physical signaling interface is separated from members (applications) that generate the message via an interpreter module. The interpreter runs a program that transforms the signaling message generated by the members into a message that is easily transmissible in a communication network possibly possessing transmission protocol converters at interposed nodes prior to the signaling message reaching the exchange to which it is addressed. Accordingly, unlike the conventional techniques where the member must be directly connected to a circuit to put the message in the known form, in the Appellant's invention, the interpreter selects the signaling configuration for the message of the member and sends it to the respective circuit (Fig. 1; page 5 of the specification).

In the Appellant's invention, the message is first composed by an operator in a member and is sent to the interpreter. In the interpreter, the message receives a predetermined additional character string, which string is always the same. This character string represents a send order.

That predetermined order (character string) is added to the message whatever the protocol that is to be used thereafter to convey it to the destination exchange. The interpreter then interprets the predetermined order *i.e.*, the interpreter adapts the encapsulation of the message to a signaling transmission protocol available at its interface and puts into operation the circuit corresponding to the selected signaling transmission protocol (Fig. 2; page 6 of the specification). There are a number of ways to select a transmission protocol when more than one is available at the exchange *e.g.*, chronologically, hierarchically, and so on (page 7, lines 5 to 12 of the specification). When the transmission protocol is selected, the signaling message is sent by the respective circuit of the physical signaling interface (page 7, lines 13 to 14 of the specification).

When a signaling message is received, the message is interpreted by the interpreter by receiving a flag indicating that this message is received from outside and not from one of the members (page 7, lines 14 to 28 of the specification). After the flag has been added, a test is performed to see whether the destination of this signaling message has been reached. If the destination has been reached, the message is processed. However, if the destination is not reached, the received flag is replaced with a predetermined character string indicating an order to send and then the message is sent in accordance with operations described in the preceding paragraph (page 7, line 29 to page 8, line 12 of the specification). The interpreter may be a microprocessor associated with a program or a working session in a processor running in the exchange (page 8, lines 21 to 24 of the specification).

Accordingly, in the Appellant's invention the message is transmitted transparently through various physical interfaces (circuits) and that the transmission of the signaling message

no longer depends on the specific physical means actually available at the physical signaling interface (page 8, lines 12 to 28).

A. *Claim 1*

Independent claim 1 requires a switch having a coupler accessing signaling channels to transmit signaling messages. A coupler is designed to be placed in a telephone exchange having channels for carrying signaling data between network inlet and outlet (Fig. 1; page 4, lines 17 to 36 of the specification).

The switch further includes an interpreter which transforms a received signaling message into a message that is easily transmissible (Fig. 1; page 5, lines 4 to 11 of the specification). The interpreter selects the signaling configuration of the coupler 1 so as to enable it to adapt to transmitting the received signaling message (Fig. 1; page 5, lines 32 to 36 of the specification).

Specifically, the interpreter receives a predetermined additional character string, which is always the same. This character string represents a sent order. This predetermined sent order is added to the message "signaling" whatever the protocol that is to be used thereafter for conveying it to an exchange (Fig 2; page 6, lines 5 to 22 of the specification). The interpreter interprets the character string and in so doing, the interpreter encapsulates the received message into the transmission protocol available at the coupler (Fig. 2; page 6, lines 24 to 33 of the specification).

The switch further includes a receiver for adding a receive flag to a received signaling message (Fig. 2; page 7, lines 14 to 28 of the specification).

B. Claim 2

Claim 2 recites that the coupler further includes a detector recognizing whether the received signaling message is addressed to the switch (Fig. 2; page 7, lines 31 to 35 and page 8, lines 13 to 28 of the specification) and a processor processing the signaling message when the switch is a destination for the signaling message (Fig. 2; page 7, lines 35 to 37 and page 8, lines 13 to 28 of the specification). The coupler further includes a translator replacing the receive flag with the predetermined character string when the switch is not the destination for the signaling message (Fig. 2; page 8, lines 1 to 5 and lines 13 to 28 of the specification).

C. Claim 3

Independent claim 3 is directed to a method of sending a signaling message by a switch. The method includes adding to the signaling message a predetermined send order for the signaling message (Fig. 2, page 6, lines 9 to 23 of the specification). The operation of adding also includes the switch receiving the signaling message in a receiving exchange and adding a receive flag to the signaling message (Fig. 2, page 7, lines 14 to 31 of the specification). The method further includes interpreting the send order in an interpreter of the switch to produce a signaling configuration of the switch, where the signaling configuration produced depends on a type of signaling channels available to the switch (Fig. 2; page 6, line 24 to page 7, line 11 of the specification). In this method, the receive flag is a specified constant (page 3, lines 4 to 24 and page 7, lines 27 to 31 of the specification). Also, in this method, the predetermined send order is a specified constant character string (page 3, lines 4 to 24 and page 6, lines 5 to 20 of the specification).

D. Claim 11

Claim 11 depends on claim 2, and recites that when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message (Fig. 2; page 7, lines 27 to 31 of the specification). Claim 11 further recites that the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message (Fig. 2; page 7, lines 31 to 37 of the specification).

E. Claim 12

Claim 12 depends on claim 2 and requires that when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the destination for the signaling message (Fig. 2; page 3, lines 4 to 15, page 6, lines 9 to 20, and page 8, lines 1 to 5 of the specification).

F. Claim 13

Claim 13 depends on claim 12 and requires that when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the signaling configuration of said signaling message (Fig. 2; page 3, lines 4 to 15, page 6, lines 9 to 20, page 6, line 27 to page 7, line 11, and page 8, lines 1 to 5 of the specification).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are three issues on Appeal. The first issue is whether claims 12 and 13 are improperly finally rejected under 35 U.S.C. § 112, first paragraph. The second issue is whether claims 1, 3, 5, 7 and 8 are improperly finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,595 to Hickey et al. (hereinafter “Hickey”) and the third issue is whether claims 2, 4, 6, and 11-13 are improperly finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al. (hereinafter “Kabay”).

VII. ARGUMENT

Appellant respectfully requests the Board to reverse the Examiner's rejections of the claims pending in the application for at least the following reasons.

Issue 1: Claims 12 and 13 Are Enabled.

Claims 12 and 13 are rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement.

Specifically, in response to Applicant's arguments, the Examiner alleges that "the specification is completely void of *any phrasing* or *similar language*," emphasis added (*see* page 2 of the Final Office Action). In the Advisory Action dated October 19, 2005, the Examiner alleges that Appellant's invention as original filed does not indicated that at the time of the invention Appellant contemplated the features of claims 12 and 13 and that the specification does not convey to one of ordinary skill in the art that at the time of the invention, Appellant was in possession of the claimed invention (*see* Continuation Sheet).

Appellant respectfully submits that a patent document is not intended to be a production specification. Northern Telecom v. Datapoint 15 USPQ2d 1321, 1328-30 (Fed. Cir. 1990); U.S. v. Teletronics 8 USPQ2d 1217, 1222-24 (Fed. Cir. 1988). It is respectfully submitted that one of ordinary skill in the art, given specification, and knowledge generally available, could readily understand that "the send order" is placed when the switch is not the destination *i.e.*, when the message is to be send as opposed to being processed. In other words, "the send order" does not depend on the destination. Regardless of which exchange is designated as the destination, if the message is to be send, the same "send order" is added. Indeed, the Examiner has not provided any reason or evidentiary support for concluding the contrary.

MPEP § 2163.02 specifically states that “the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art **would not recognize** in the Appellant’s disclosure a description of the invention defined by the claims. MPEP § 2163.04. In fact, there is no need for the specification to explicitly describe the unique features of the invention being claimed. Each claim limitation need only be explicitly, implicitly, or inherently supported in the originally filed disclosure, MPEP § 2163.05.

One of ordinary skill in the art would readily appreciate and recognize the unique features of the invention claimed in claims 12 and 13 from the original specification. For instance, in the exemplary, non-limiting embodiment, Fig. 2 shows that when the destination of the signaling message is “not here” i.e., not the switch, step 26, a flag with a predetermined order corresponding to “send order” is added, step 27 (*see* Fig. 2 and page 7, line 27 to page 8, line 12 of the specification).

The predetermined “send order” is to be added to the message whatever the protocol that is to be used thereafter in conveying it to the exchange 19 (*see* page 6 of the specification). Specifically, page 6, lines 9 to 12 of the specification recite:

[i]n the interpreter 14, the message
“SIGNALLING” produced by the member 15
receives a predetermined additional
character string in operation 22, which
string is **always the same**, emphasis added.
[t]his character string represents a send
order.

That is, one of ordinary skill in the art would readily appreciate that the same predetermined order i.e., “send order” is added to the message in order to send the message regardless of the

destination of the message, as is also explicitly states in the exemplary embodiment of the present invention. When the signaling message is to be send, the destination is irrelevant, as the same send order will be added. Accordingly, claims 12 and 13 are enabled.

For at least the above-discussed exemplary reasons, Appellant respectfully requests the Board to reverse this rejection of claims 12 and 13 under 35 U.S.C. § 112, first paragraph.

Issue 2: Claims 1, 3, 5, 7, and 8 are Novel and are Not Anticipated by Hickey.

Claims 1, 3, 5, 7, and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,595 to Hickey et al. (hereinafter "Hickey"). Appellant respectfully requests the Board to reverse this rejection in view of the following remarks.

A. Claim 1

Independent claim 1 recites a number of unique features not taught by the prior art references cited by the Examiner. For example, claim 1 recites:

an interpreter producing a signaling configuration upon receiving an order to send a signaling message, the signaling configuration produced depends on a type of the signaling channels accessible to the coupler...

For example, an illustrative, non-limiting embodiment of the present invention discloses a switch that is capable of transmitting and receiving signaling messages in a variety of communication channels without having a transcoder for each communication channel. In particular, in the exemplary embodiment, a switch with an interpreter is provided, which transmits signaling messages in a variety of forms based on the signaling channels available to the switch. In this exemplary embodiment, a predetermined instruction string (order) is added to the signaling message. The predetermined order is always the same regardless of the type of signaling message.

In response to the order, the interpreter of the exemplary embodiment of the present invention, encapsulates the signaling message according to the type of channel available at the switch. Upon receipt of this message by another switch, the recipient switch adds a "received" instruction to the signaling message and then, checks to see if the message is addressed to this switch. When the signaling message is not addressed to this switch, a "send" order is added, and the signaling message is reconfigured based on a type of channels available at this recipient switch. For example, if the switch only has an X25 type of channel, then the signal is configured to be transmitted over this X25 type of channel even if the original signal is in a different type. On the other hand, if the switch has a number of channels available, then the interpreter can decide which type of channels to use (*e.g.*, first available link in chronological order).

It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to further understanding of the distinguishing aspects of the claims mentioned further above.

B. Prior Art

Hickey, on the other hand, discloses a process of sharing and transferring information between ISDN telephones (see *Abstract*). In particular, Hickey discloses a telephone user at Station A placing a call to the WAW telephone 12 at Station B. Hickey further discloses that the Station B site is unattended and the WAW telephone 12 has been placed in the remote operation mode by activating the LOCAL/REMOTE pushbutton 38. Since the Station B is an unattended site, the WAW telephone 12 will ring "no answer", and the calling line ID information will be transmitted to a Station C, and if requested by the WAW telephone 14, Station A's call will be transferred to the Station C (Figs. 1 and 4; col. 3, lines 22 to 54).

Hickey discloses that incoming D channel messages are monitored by WAW telephone 12 and a determination is made as to whether an incoming call is present. Next, a check is made to determine whether the WAW telephone 12 is in the local or remote mode. If, the WAW telephone is in the local mode, a normal call processing continues. On the other hand, if the WAW telephone 12 is in the remote operating mode, the incoming calling line ID is stripped out and stored in RAM 54. Then, a setup message is constructed and sent over the D channel. The outgoing setup message from the Station B to the Station C contains the calling line ID of the Station A, a calling party sub-address, or lower layer compatibility information elements. Along with the calling line ID, a flag or code is included to indicate to the Station C that this call is from the WAW telephone 12. The constructed setup message is transmitted to the ISDN network 16 via the system bus 44, the signaling channel 46, and the network interface 42 (Fig. 4; col. 3, line 43 to col. 4, line 5).

In other words, Hickey discloses a method of transferring information between ISDN telephones that are operable in either a local mode or a remote mode. The telephones are placed in the local mode when the user is available to accept calls and is placed in the remote mode when the user wishes the incoming calls or other information to be transferred to a companion phone at a different location. The selection of the telephone mode may be controlled locally or from a remote location (col. 1, lines 39 to 48).

C. Legal Standard

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus,

the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

D. Appellant's Position

Appellant respectfully submits that the unique combination of claim 1 including at least the claimed signaling configuration produced depends on a type of the signaling channels accessible to the coupler is absent from the teachings of Hickey.

Hickey is unrelated to the invention set forth in claim 1. Hickey is directed to sharing and transferring information between phones and has nothing to do with a switch transmitting and receiving signaling messages for/from a variety of communication channels without having a transcoder for each type of signaling message. Hickey fails to even suggest a non-uniform network where transcoders may need to be used. In fact, Hickey only discloses a conventional setup of having B (bearer channels) channels for data and one single delta (D) channel for signaling messages (col. 1, lines 27 to 36).

Moreover, Hickey only discloses sending the signaling message over a single D channel. Hickey fails to disclose producing a signaling configuration based on a type of signaling channels accessible to the network interface 42. Hickey fails to disclose any correlation between the D channel and the setup message. It is simply not the focus of Hickey's disclosure.

The Examiner alleges that Hickey's "D-channels" disclose producing signaling configuration depending on a type of the signaling channels accessible to the coupler, as set forth in claim 1 (*see* pages 3-4 of the Final Office Action mailed June 23, 2005). Appellant respectfully submits, however, that Hickey discloses one single signaling channel D (col. 1,

lines 22 to 26 and col. 3, lines 9 to 11). That is, in Hickey, there is no “plurality of signaling channels D,” as alleged by the Examiner.

Furthermore, Hickey fails to disclose or suggest any correlation between the D channel and the setup message. The Examiner alleges that having “an incoming call be presented as a D channel message to the network interface which passes the D channel message through the D signaling channel” somehow discloses producing the signaling configuration that depends on a type of signaling channels (*see* page 3 of the Final Office Action mailed June 23, 2005). However, no dependency or correlation between the signaling message and type of channels accessible to the coupler is present in this phrase.

Hickey only discloses that the message is received and is sent though the D channel. That is, in Hickey, the D channel is used for conveying signaling packets to effect signaling message between the ISDN telephones and the network (col. 3, lines 8 to 20). Hickey’s disclosure of sending the message over the D channel fails to anticipate producing signaling configuration based on a type of signaling channels accessible to the coupler. In Hickey, there is no disclosure or suggestion that the type of signaling channel somehow impacts the signaling configuration.

Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Appellant respectfully submits that Hickey’s disclosure of having a D message transmitted on a D channel fails to disclose or suggest producing the signaling configuration depending on the type of signaling channels accessible to the coupler.

In the Advisory Action mailed October 19, 2005, the Examiner alleges that the features being argued are not recited in claim 1. That is, the Examiner proposes reciting that the signaling configuration is produced based on which of the plurality of types of channels are accessible to the coupler (*see* Continuation Sheet). Appellant respectfully submits, however, that as explained in greater detail above, Hickey fails to disclose a) producing signaling configuration, which depends on the type of signaling channels accessible to the coupler because Hickey fails to disclose or suggest any correlation between the configuration and the type of signaling channels, and c) having signaling channels accessible to the coupler because in Hickey, there is only one signaling channel.

E. Conclusion

Therefore, “an interpreter producing a signaling configuration upon receiving an order to send a signaling message, the signaling configuration produced depends on a type of the signaling channels accessible to the coupler...,” as set forth in claim 1 is not suggested or taught by Hickey, which lacks having more than one signaling channel accessible to the network interface and producing the signaling configuration based on the type of the signaling channels accessible to the network interface. For at least these exemplary reasons, Appellant respectfully submits that claim 1 is patentably distinguishable and is patentable over Hickey.

Therefore, Appellant respectfully requests the Board to reverse this rejection of claim 1.

F. Other Claims

Next, independent claim 3 recites features similar to the features argued above with respect to claim 1. Since claim 3 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force

here. For at least substantially analogous reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 3 and its dependent claim 5.

Furthermore, since claims 7 and 8 dependent upon claim 1, they are patentable at least by virtue of their dependency.

Issue 3: Claims 2, 4, 6, and 11-13 are Unobvious in view of Hickey and Kabay.

Claims 2, 4, 6, and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey in view of U.S. Patent No. 5,949,871 to Kabay et al. (hereinafter "Kabay").

Applicant respectfully traverses this rejection in view of the following comments.

Claims 2 and 9-13 depend on claim 1 and claims 4 and 6 depend on claim 3. Appellant has already demonstrated that Hickey fails to disclose or suggest the unique features of the independent claims 1 and 3. Kabay does not cure the deficient teachings of Hickey.

Kabay discloses an improved method of providing services in the telecommunications network for ported clients (clients which kept their number but changed the provider) by means of using an interceptor (col. 5, lines 40 to 65). Specifically, this interceptor intercepts a control message (e.g., Initial Address Message) and checks whether the caller or the receiver is a ported client by checking the dial number and the called party number. If the caller or the called party is a ported client, then the interceptor accesses the type and values of an IAM and compares them with stored service trigger data (Fig. 15; col. 13, lines 10 to 19). Next, at least one of the call-related parameters of the control message is modified to effect some of the required service implementation action. Basically, this interceptor sends out a new IAM with destination data set in dependence on the location routing number (col. 16, lines 1 to 67).

Kabay, however, clearly fails to cure the deficient teachings of Hickey in that it also fails to disclose or suggest producing signaling configuration based on a type of the signaling channels that are accessible to the coupler. Therefore, dependent claims 2, 4, 6, and 9-13 are patentable over the combined teachings of Hickey and Kabay at least by virtue of their dependency on claim 1 or 3.

In addition, dependent claim 2 recites that *the coupler comprises: a detector recognizing whether the receiver signaling message is addressed to the switch*. The Examiner alleges that Kabay's interceptor ascertaining whether service implementation action is required with respect to the call associated with the control message discloses a detector recognizing whether the received signaling message is addressed to the interceptor box (*see* pages 4-5 and 8 of the Final Office Action mailed June 23, 2005).

Appellant respectfully submits that Kabay discloses intercepting the message, and processing the trigger data when the call comes from a ported caller or to a ported called party. To recognize the interceptor box, an address or some form of identification is needed. Appellant respectfully submits that as the name "interceptor" suggests, Kabay's interceptor box has no identification. Indeed, the interceptor box is not configured to perform the functionality of recognizing whether the received message is addressed to the interceptor box, and without some sort of identification such detection is impossible. Moreover, the detector as set forth in claim 2 is part of a coupler of the switch, whereas the interceptor box is a separate entity and not a part of another entity (Fig. 10; col. 7, lines 43 to col. 8, line 10).

For at least these additional reasons, Appellant respectfully submits that claim 2 is patentable over the combined teachings of Hickey and Kabay.

In addition, dependent claim 11 recites: “when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message and the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message.” The Examiner alleges that Hickey discloses these unique features of claim 11 (*see* page 9 of the Final Office Action). However, the Examiner acknowledged with respect to claim 2 that Hickey fails to disclose or suggest a detector (*see* page 8 of the Final Office Action). Accordingly, Appellant respectfully submits that the Examiner’s position with respect to claim 11 is inconsistent with the position taken with respect to claim 2.

Moreover, Appellant respectfully submits that Hickey fails to disclose or suggest “the receiver adds a receive flag to the signaling message and the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message.” The Examiner alleges that a flag or code disclosed in the col. 4, lines 1 to 25 of Hickey meet the unique features of claim 11 (*see* page 9 of the Office Action).

In col. 4, lines 1 to 25, Hickey recites:

Along with the calling line ID, a flag or code is included to indicate to Station C that this call is from the WAW telephone 12. The constructed setup message is transmitted to the ISDN network 16 via the system bus 44, the signaling channel 46, and the network interface 42 (emphasis added).

Referring now to FIG. 5, a flowchart of a portion of the software that controls operation of the WAW telephone 14 at Station C is shown. Incoming D channel messages are monitored at block 74. At block 76 a determination is made as to whether an incoming call is present. If the call is from the WAW telephone 12, the flag or code contained in a D channel message will be detected at block 78. At block 80 the WAW

telephone will produce an audibly alert (ring), a visual alert by energizing one of the lamps 26, display Station A's calling line ID on display 24, and energize a lamp indicating that this call is being received from the WAW telephone 12. If the user chooses to ignore the incoming call, the telephone will continue to ring until the call is either answered or abandoned. If the call is answered, as detected at block 82, the WAW telephone 14 responds with the usual Q.931 signaling messages, stored in ROM 52, as indicated at block 84. If the flag or code in the D channel message is not present as determined at block 78, indicative of a call from other than the WAW telephone 14, then normal call processing continues as indicated at block 86 (emphasis added).

In other words, as is visible from the quoted passage above of Hickey, the flag or code is not added by the receiver, Station C. Moreover, the flag or code does not designate the destination of the message but its source. In other words, the flag or code indicates where the call is from (col. 4, lines 1 to 3) and not the destination. In short, Hickey fails to disclose or suggest "when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message and the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message."

Kabay fails to cure the deficient teachings of Hickey. Kabay's interceptor box (alleged detector, page 8 of the Final Office Action), intercepts a control message (e.g., Initial Address Message) and checks whether the caller or the receiver is a ported client by checking the dial number and the called party number, and replaces some of the parameters when the caller or the receiver is a ported client (Fig. 15; col. 13, lines 10 to 19). Kabay, however, fails to disclose or suggest "when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message." Moreover, Kabay fails to disclose or suggest the detector checking the

signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message, as the interceptor will never be the destination of the message.

For at least these additional reasons, Appellant respectfully submits that claim 11 is patentable over the combined teachings of Hickey and Kabay.

In addition, dependent claim 12 recites: "when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the destination for the signaling message." The Examiner acknowledges that Hickey does not disclose or suggest these unique features of claim 12. The Examiner, however, alleges that Kabay cures the deficient teachings of Hickey. For support, the Examiner relies on col. 7, lines 62 to 65 of Kabay (*see* page 9 of the Final Office Action).

Col. 7, lines 49 to 65 of Kabay recite:

Party A (EO1) is attempting to contact B who has now ported from carrier 1 (EO2) to carrier 2 (EO3). The objective is to deliver the call to party B on EO3 using the original carrier 1 number.

(1) EO1 simply launches an IAM to EO2 based on the DN [dial number] received from party A. A speech path is set-up between EO1 and EO2.

(2) A message interceptor intercepts the MSU [message signal unit] traffic from the links between EO1 and the STP [signaling transfer point]. This is done on a per-link basis. For each IAM detected, an LNP [local number portability] database lookup is performed across a data network to determine if the Called Party Number (CdPN) is ported.

(3) The database returns an LRN [location routing number]. For non-ported customers the LRN will be the same as the original CdPN. However, if the customer has ported the LRN will be different from the original CdPN.

As is visible from the above quoted passage, Kabay's LNP, CdPN, and LRN clearly depend on the called party *i.e.*, the destination. That is, Kabay fails to disclose or suggest replacing LRN (alleged receive flag) with CdPN (alleged predetermined character string) regardless of the destination at least because both numbers very much depend on the destination *i.e.*, the called party. Moreover, in Kabay, when a party is not ported, the LRN is not replaced with the CdPN. That is, in Kabay, the replacement is necessary only when the party is ported.

For at least these additional reasons, Appellant respectfully submits that claim 12 is patentable over the combined teachings of Hickey and Kabay.

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

VIII. CONCLUSION

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: April 26, 2006

Nataliya Dvorson
Registration No. 56,616

Attorney Docket No.: Q54622

CLAIMS APPENDIX

CLAIMS 1-8 AND 11-13 ON APPEAL:

1. A switch comprising:

a coupler accessing signaling channels to transmit signaling messages;

an interpreter producing a signaling configuration upon receiving an order to send a signaling message, the signaling configuration produced depends on a type of the signaling channels accessible to the coupler; and

a receiver for adding a receive flag to a received signaling message,

wherein the order is a predetermined constant character string.

2. The switch according to claim 1, wherein the coupler further comprises :

a detector recognizing whether the received signaling message is addressed to the switch;

a processor processing the signaling message when the switch is a destination for the signaling message; and

a translator replacing the receive flag with the predetermined character string when the switch is not the destination for the signaling message.

3. A method of sending a signaling message by a switch, the method comprising:

adding to said signaling message a predetermined send order for said signaling message,

said adding further comprises the switch receiving the signaling message in a receiving exchange

and adding a receive flag to the signaling message; and

interpreting said send order in an interpreter of the switch to produce a signaling configuration of said switch, the signaling configuration produced depends on a type of signaling channels available to the switch,

wherein the receive flag is a specified constant and the predetermined send order is a specified constant character string.

4. The method according to claim 3, wherein, to add the predetermined character string to the signaling message:

the destination of said signaling message is tested; and

if a destination of the signaling message is different from said receiving exchange, the flag is replaced by said predetermined character string.

5. The method of claim 3, wherein said interpreter is configured to process at least one of: an IP protocol, a frame relay protocol, an ATM protocol, a switched X25 protocol, a generic modem protocol and a switched B channel protocol.

6. The method of claim 3, wherein said interpreter is one of (a) a microprocessor associated with a program and (b) a working session in a processor running said switch.

7. The switch of claim 1, wherein said interpreter comprises a circuit configured to process at least one of: an IP protocol, a frame relay protocol, an ATM protocol, a switched X25 protocol, a generic modem protocol and a switched B channel protocol.

8. The switch of claim 1, wherein said interpreter comprises one of (a) a microprocessor associated with a program and (b) a working session in a processor running said switch.

11. The switch of claim 2, wherein when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message and the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message.

12. The switch of claim 2, wherein when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the destination for the signaling message.

13. The switch according to claim 12, wherein when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the signaling configuration of said signaling message.

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

EVIDENCE APPENDIX:

NONE.

AMENDED APPEAL BRIEF
U.S. Appln. No. 09/323,135
Attorney Docket No.: Q54622

RELATED PROCEEDINGS APPENDIX

NONE.